

REMARKS

Applicants have carefully considered the February 16, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance.

Claims 1-17, 19 and 20 are pending in this application. In response to the Office Action dated February 16, 2006, claims 5, 7 and 10-13 have been recast in independent claim form and claim 20 has been amended to depend from claim 16 instead of claim 6.

Applicants submit that the present Amendment places the application in condition for allowance. Rewriting claims in independent form does not change claim scope and the change in the dependency of claim 20 only corrects an antecedent basis issue. Hence the Amendment does not generate any new matter issue or any new issue requiring any further search and/or consideration. At the very least, the Amendment reduces issues for Appeal, by elimination the basis for an indefiniteness rejection. Accordingly, entry of the Amendment and prompt favorable reconsideration pursuant to 37 C.F.R. § 1.116 are respectfully requested.

Claim 20 was rejected under the second paragraph of 35 U.S.C. § 112. The Examiner indicated that the term “management module” lacks antecedent support. Applicants have amended claim 20 to depend from claim 16 to provide antecedent support for the claim term “management module”. Therefore, it is respectfully submitted that the imposed rejection of claim 20 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Claims 1-17, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundblad et al. (WO 00/23952, hereinafter “Lundblad”) in view of Jones et al. (U.S. Pat. App. No. 2006/001007, hereinafter “Jones”). Applicants respectfully traverse.

The present claimed subject matter, as described in each of independent claims 1, 5, 7 and 10-13, recites a banknote handling device comprising, inter alia, a counterfeit processing module that stores each banknote determined as counterfeit into the counterfeit collection box and prohibits the stored counterfeit banknote from being returned to the customer. The independent claims further require a notification module that notifies the customer of predetermined kind of information. The information provided for the customer, in the notification, is indicative of a total amount of money received from the customer and is indicative of an amount of money settled as a transaction; regardless of the result of the counterfeit detection by the discrimination module. Thus, The two features of the present claimed subject matter are summarized as follows: (a) a counterfeit banknote is recovered into a counterfeit collection box and is not returned to a customer; and (b) the customer is notified of information for specifying a total amount of money received from the customer (including counterfeit banknotes).

The rejection asserted that Lundblad provides feature (a) by disclosing a process of printing a receipt containing a number of (suspicious) banknotes and information of a customer. See Lundblad at page 4, beginning at line 28. The Examiner recognized that Lundblad fails to disclose giving a copy of the receipt to the customer. However, the rejection alleged that it is obvious for a person skilled in the art to provide a customer with transaction data in the form of a written receipt to provide the customer with a means of updating personal records and to authenticate monetary transactions.

With regard to feature (b), the Examiner admitted that although Lundblad fails to disclose notifying a customer of the total amount of money (including counterfeit banknotes). Nevertheless the rejection asserted that it is well known in the art to notify the customer of transaction data involved with a counterfeit detecting apparatus, as suggested by Jones at numbered paragraphs [0057], [0058], [0063], and [0147]. Applicants respectfully traverse.

Applicants submit that Jones does not teach or suggest providing notification to the customer regarding information for specifying a total amount of money received from the customer, including counterfeit banknotes (feature (b)). The Examiner's attention is directed to Fig. 3a (steps 230-282) of Jones, and the corresponding description at paragraphs [0057] and [0058], wherein Jones discloses outputting banknotes to an output receptacle whether they are genuine or counterfeit banknotes. Further, at Fig. 3b and paragraph [0063], Jones discloses outputting checks (not currencies) to the output receptacle whether the checks are genuine or counterfeit. Thus it should be apparent that the configuration of Jones is different from the present claimed subject matter in which "a counterfeit banknote is recovered into a counterfeit collection box and is not returned to a customer."

Furthermore, paragraph [0147] of Jones describes displaying the amount of money. Paragraphs [0137] through [0147] of Jones describe the contents of Figs. 17a-19a. In Fig. 17a, there is no counterfeit banknote, and the \$141 received from a customer is credited to the customer's account in step 1780. Paragraph [0141] of Jones describes Fig. 18a in which there are counterfeit banknotes of \$5 and \$20, and the amount of genuine banknotes '\$116' is displayed in step 1805, and the reason for the reduction is presented in step 1810. Fig. 19a shows that the banknotes are transferred to a Bank A and then undergo further verification if there is no counterfeit banknote in step 1785. Paragraph [0146] of Jones discloses that if the

further verification finds a counterfeit banknote of \$50, then the amount of \$50 is deducted from the customer's balance in step 1960.

The rejection asserted that Jones, at paragraph [0147] discloses that Bank A may choose not to deduct the amount of counterfeit banknote from the account and, therefore, the rejection concluded that it would have been obvious to notify the customer of 'the total amount of money received.' However, Jones does not teach or suggest notifying the customer of 'the total amount of money received' when the transaction is made. Rather, Jones only describes how to process the customer's account after the banknotes are removed from the scanner and then transferred to the Bank A. Therefore, Jones does not teach or remotely suggest notifying the customer of the total amount at the time of transaction.

Furthermore, Jones only discloses a device which verifies whether banknotes or checks received from the input receptacle are genuine or counterfeit, and then transfers them to the output receptacle as shown in Figs. 1, 2, 5, 11-14, and 20-23. Jones does not teach or suggest a banknote handling device which includes a storage box for storing banknotes and a counterfeit collection box. Therefore, Jones does not teach or suggest the feature (a) or (b) of the present independent claims. As such, even if Jones is combined with Lundblad as suggested by the Examiner, the claimed subject matter would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Based upon the arguments submitted *supra*, it should be apparent that a *prima facie* basis to deny patentability to the claimed subject matter has not been established for want of the requisite factual basis.

The patentability of claims 5 and 15 is separately argued. Claims 5 and 15 include a feature that the counterfeit collection box is disposed outside of the safe. The advantage of this structure is disclosed in the specification at page 17, lines 8-23. Lundblad includes a packaging

or encasing unit 18 for storing counterfeit banknotes which is disposed in the similar location as a storage device 14 for storing banknotes. The location is considered as the inside of the safe and, therefore, contrary to the assertion in the rejection, Lundblad fails to disclose or suggest a counterfeit collection box is disposed outside of the safe. Jones fails to remedy the above argued deficiency of Lundblad.

The patentability of claim 7 is separately argued. Claim 7 includes the feature that a setting module that specifies at least one of storage boxes to the counterfeit storage box. In Lundblad, the packaging or encasing unit 18 for storing counterfeit banknotes is fixed, and the storage device 14 is not used for storing counterfeit banknotes. Accordingly, Lundblad fails to teach every limitation of claim 7 as alleged by the Examiner. Moreover, Jones fails to remedy the above argued deficiency of Lundblad with respect to claim 7.

The patentability of claim 12 is separately argued. Claim 12 includes the feature that each counterfeit banknote stored in the counterfeit collection box is mapped to customer information. Lundblad teaches the concept of packaging a plurality of banknotes into a single package on each transaction. The present claimed subject matter stores banknotes into the counterfeit collection box without packaging and maps each banknote to customer information. Therefore, Lundblad fails to teach every limitation of claim 12 as alleged by the Examiner. Moreover, Jones fails to remedy the above argued deficiency of Lundblad with respect to claim 12.

The patentability of claim 13 is separately argued. Claim 13 includes the feature that genuine banknotes are also recovered at the counterfeit collection box, and banknotes received from each customer are separated from banknotes received from other customers. In contrast, Lundblad stores only counterfeit banknotes in the packaging or encasing unit 18 and, therefore,

Lundblad fails to teach every limitation of claim 13 as alleged by the Examiner. Moreover, Jones fails to remedy the above argued deficiency of Lundblad with respect to claim 13.

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundblad in view of Katou et al. (U.S. Pat. No. 6,481,620, hereinafter “Katou”). Applicants respectfully traverse.

Claims 10 and 11 include, *inter alia*, a temporary storage box that temporarily keeps the banknotes received through the money-in module. The Examiner admitted that Lundblad does not include a temporary box. Nonetheless, the rejection asserted that Katou discloses a temporary storage box and, therefore, it would have been obvious to include a temporary storage box in Lundblad’s device in order to place banknotes in escrow and prior to distribution based upon a determination of banknote characteristics. Applicants traverse.

Katou discloses a bill recycling machine that is not remotely concerned with identifying counterfeit banknotes, much less addressing counterfeit problems associated with banknote handling devices. In imposing a rejection under 35 U.S.C. § 103, the Office and the Examiner are charged with the initial burden of making the requisite factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the machine disclosed by Lundblad to arrive at the claimed subject matter based upon specific objective evidence – not generalizations. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000), *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000), *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Moreover, such evidence must be within the prior art not within Applicant’s own disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir.

1985). In applying the above legal tenets of the exigencies of this case, Applicants submit that the rejection based on Lundblad and Katou has not established the requisite motivational element. The Office action has offered no explanation as to why one having ordinary skill in the art would somehow have been lured to zero in on a temporary storage box of Katou and force it into Lundblad's banknote handling machine. The assertion of obviousness amounts to nothing more than a generalization. Accordingly, the rejection is not legally viable and should be withdrawn.

It is believed that pending claims 1-17 and 19-20 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck  
Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:idw  
Facsimile: 202.756.8087  
**Date: June 28, 2006**

**Please recognize our Customer No. 20277  
as our correspondence address.**